

Remarks

The Examiner rejected claims 1, 2, 6-8, 13-15 under 35 USC §102 as being anticipated by U.S. Patent No. 1,852,883 to Gustaveson ("Gustaveson"). Based on the following remarks, Applicant respectfully submits all claims are in condition for allowance.

All claims relate to an outsole having a top surface with a plurality of notches and a footbed with a bottom surface with a plurality of channels, said plurality of channels being in communication with the plurality of notches for ventilating the shoe.

The Final Office Action states Gustaveson teaches a shoe comprising...a plurality of channels 5-9 and a plurality of notches 10. However, as evident from figure 3 of Gustaveson, the plurality of notches 10 are not notches but are protrusions. See the bottom surface of top tread member 4. These protrusions, as stated in the Final Office Action, are in communication with the channels (also see figure 3) but they do not ventilate the shoe. In fact, the notches teach away from Applicant's claimed invention since Gustaveson's notches inhibit ventilation since it occupies space that would otherwise be used for air to pass through. "Projections or beads 10 shaped and positioned to fit into the various grooves 5, as shown in figure 3." Col. 2, lines 56-62 (emphasis added). Applicant's channels and notches come together to define a passage through which air passes (see Applicant's figure 4 as compare with Gustaveson's figure 3).

Therefore, Gustaveson lacks Applicant's limitation directed to notches in the bottom surface of the footbed and that the notches are in communication with the channels of the top surface of the outsole for ventilating the shoe. Because Gustaveson does not anticipate two of the claimed elements of Applicant's claims, Gustaveson

cannot anticipate the claimed invention and the rejections with respect to Gustaveson under 35 USC §102 should be withdrawn.

The Examiner rejected claims 3-5, 9, 16 and 18-19 under 35 USC §103 as being unpatentable over Gustaveson in view of U.S. Patent No. 4,888,887 to Solow ("Solow"). The Examiner seems to rely on Solow to show a filter and through hole on the side of the outsole. The Examiner does not seem to rely on Solow, and Solow does not teach or suggest, an outsole with a plurality of notches in a top surface of an outsole.

A prima facie case of obviousness requires that the Examiner show that the proposed combination teaches all of the claimed elements, that there is motivation for the combination, and that there is a reasonable expectation of success for the combination. Because no reference alone or in any combination with one another relates to a plurality of notches in the bottom surface of the footbed and that the notches are in communication with the plurality of channels in the top surface of the outsole for ventilating the shoe, the proposed combination cannot include the claimed plurality of notches. When no reference refers to such claimed features, the motivation to combine the stated references in a manner to include Applicant's claimed feature is also absent. The reasonable expectation of success prong is moot given Examiner's failure to satisfy the "all-elements" and motivation prongs.

Moreover, Gustaveson teaches away from Applicant's claimed plurality of notches in the bottom surface of the footbed where the notches are in communication with the plurality of channels in the outsole for ventilating the shoe. Gustaveson teaches protrusions in the bottom surface of the footbed and that such protrusions are placed in the plurality of channels in the outsole, where the protrusions are placed into the volume created by the channels and inhibit air flow within the channels. Since Gustaveson teaches away from Applicant's invention, and because there is no

disclosure, teaching, or suggestion in any reference to a plurality of notches in the bottom surface of the footbed and that the notches are in communication with the channels of the top surface of the outsole for ventilating the shoe, the combination of the references do not arrive at Applicant's claimed invention without some modification to the combination.

Even assuming that somehow the cited references may be combined, in order for a reference to be properly modified in a rejection under 35 USC §103, there must be some teaching or suggestion to make the modification. Without some teaching or suggestion, one skilled in the art lacks the motivation to make the modification. As discussed above, all of the references not only lack a teaching or suggestion for a plurality of notches in the bottom surface of the footbed and that the notches are in communication with the channels of the top surface of the outsole for ventilating the shoe, but also teach away from Applicant's notches. It can hardly be argued or presumed that Applicant's notches for ventilating the shoe would be obvious in view of such opposite teachings.

Based on the foregoing, Applicants' submit that all claims are allowable and that all rejections be withdrawn.

Respectfully submitted,

January 6, 2006



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